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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,357	01/17/2002	Lars Winther	3276.1002000	6915

21005 7590 05/20/2004

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EXAMINER

VAN, QUANG T

ART UNIT PAPER NUMBER

3742

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/031,357

Applicant(s)

WINTHER ET AL.

Examiner

Quang T Van

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36-56 and 69-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36-56 is/are allowed.
- 6) ☒ Claim(s) 69-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Specification***

1. The abstract of the disclosure is objected to because the legal phraseology such as "comprises" or "comprising" often used in patent claims should be avoided in the abstract. Correction is required. See MPEP § 608.01(b).
2. The abstract of the disclosure is objected to because it should avoid using phrases which can be implied, such as, " This disclosure concerns", "The disclosure defined by this invention", "This disclosure describes", "is disclosed", "are disclosed", "**the invention relates to**" etc. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 69-71 and 73-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Savas (US 5,534,231). Savas discloses a plasma reactor comprising a solid support member (46) in combination with a carrier (52) and electromagnetic inductor (42), said support member comprising an electrically conducting material (54) on the surface turning against the side of the carrier (52) carrying a specimen, and said electromagnetic inductor (42) being able to generate a magnetic field (col. 9, lines 41-46). With regard claims 73-74 are considered intended use recitation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to

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be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structure limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case, "Use of a support member in combination with an inductor according to claim 69 for treatment of a biological specimen" recited in claim 73, or "Use of a support member according to claim 73 for immunohistochemical procedures or *in situ* hybridization are considered intended use recitation" recited in claim 74, are considered intended use recitation. Thus, no patent weight is given to claims 73-74.

5. Claims 69-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Collins et al (US 5,56,501). Collins discloses a domed plasma reactor comprising a solid support member (17T) in combination with a carrier (32C) and electromagnetic inductor (30), said support member comprising an electrically conducting material (17S) on the surface turning against the side of the carrier (32C) carrying a specimen (5), and said electromagnetic inductor (30) being able to generate a magnetic field (col. 12, lines 17-30). With regard claims 73-74 are considered intended use recitation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structure limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case, "Use of a support member in combination with an inductor according to claim 69 for treatment of a biological specimen" recited in claim 73, or "Use of a support member according to claim 73 for immunohistochemical procedures or *in situ* hybridization are considered intended use recitation" recited in claim 74, are considered intended use recitation. Thus, no patent weight is given to claims 73-74.

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6. Claims 36-56 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not show or suggest said solid support member includes a cartridge for a carrier or a cover plate for a carrier and comprising an electrically conducting material, said conducting material being in contact with a layer of heat conducting material, said heat conducting material is in contact with the specimen, and said method comprising a step of subjecting said solid support to an oscillating magnetic field as recited in claims 36-54; the steps of placing the microscope slide in a cartridge comprising a chamber encompassed by a cartridge wall having an inner side, said cartridge comprising an electrically conducting material in the form of a solid piece of conducting material placed on the inner side of said cartridge wall and placing the cartridge in an induction coil and sending alternating current through said coil to generate a magnetic field as recited in claims 55-56.

***Response to Amendment***

8. Applicant's arguments with respect to claims 36-56 and 69-74 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang T Van whose telephone number is 703-306-9162. The examiner can normally be reached on 8:00Am 7:00Pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans can be reached on 703-305-5766. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



QV  
May 19, 2004



Quang T Van  
Primary Examiner  
Art Unit 3742